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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,720	01/05/2004	John O. Reed	1391-46500	2255

46133 7590 10/21/2005

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EXAMINER	
COY, NICOLE A	

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/751,720	REED ET AL.	
	Examiner	Art Unit	
	Nicole Coy	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 19-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 19-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/26/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed March 7, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-17, and 19-23 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Smits et al. (Patent Application Publication 2003/0218547).

With respect to claim 1, Smits et al. discloses a method comprising: connecting a removably coupled memory device to a connector through a sidewall of a tool body of a

downhole device while the downhole device is at the surface (see figure 2 and page 3 paragraph [0038]); lowering the downhole device, along with the removably coupled memory device, into a bore hole (see figure 1 and page 3 paragraph [0038]); operating the downhole device thereby creating data (see page 2 paragraph [0028]); storing the data to the removably coupled memory device (see pages 2-3 paragraphs [0028], [0029], and [0030]); raising the downhole device and the removably coupled memory device to the surface (see figure 2, page 2 paragraph [0024], and page 3 paragraph [0037]); and disconnecting the removably coupled memory device from the downhole device (see page 2 paragraph [0024] and page 3 paragraph [0037]).

With respect to claim 2, Smits et al. discloses coupling the removably coupled memory device to a surface computer; and reading the data from the memory device by the surface computer (see figure 5 and page 3 paragraph [0036]).

With respect to claim 3, Smits et al. discloses connecting the removably coupled memory device to the connector further comprises connecting a non-volatile memory device to the connector (see page 2 paragraph [0015].

With respect to claim 4, Smits et al. discloses connecting the removably coupled memory device to the connector further comprises coupling the removably coupled memory device to one of a measuring while drilling and logging while drilling tool (see page 2 paragraph [0014]).

With respect to claim 5, Smits et al. discloses connecting the removably coupled memory device to the connector further comprises coupling the removably coupled

memory device to a processor of the downhole device (see pages 1-2, paragraph [0013], figure 2, and page 2 paragraph [0027]).

With respect to claim 6, connecting the removably coupled memory device to the connector further comprises: coupling the removably coupled memory device within a recess in the tool body side-wall (see figure 2); and placing a cap over the removably coupled memory device and within the recess, wherein the cap seals against an internal surface of the recess (see figure 2 and page 2 paragraph [0027]).

With respect to claim 7, Smits et al. discloses a method comprising: connecting a removably coupled memory device to a downhole device while the downhole device is at the surface (see figure 2 and page 3 paragraph [0038]); lowering the downhole device, along with the removably coupled memory device, into a bore hole (see figure 1 and page 3 paragraph [0038]); operating the downhole device thereby creating data (see page 2 paragraph [0028]); storing the data to the removably coupled memory device (see pages 2-3 paragraphs [0028], [0029], and [0030]); raising the downhole device and the removably coupled memory device to the surface (see figure 2 and page 2 paragraph [0024], and page 3 paragraph [0037]); and disconnecting the removably coupled memory device from the downhole device (see page 2 paragraph [0024], wherein Smits et al. discloses that the memory is detachable and page 3 paragraph [0037]); wherein connecting the removably coupled memory device to the downhole device further comprises coupling the removably coupled memory device through a box end of a tool body of the downhole device (see page 1 paragraph [0007]); and wherein, between connecting the removably coupled memory to the downhole device and

lowering the downhole device, the method further comprises coupling the tool body within a drill string using the box end (see page 1 paragraph [0007]).

With respect to claim 8, Smits et al. discloses a downhole tool comprising: a downhole tool body comprising an outer surface (see figure 1); a processor disposed within the downhole tool body (see figures 1 and 2 and page 2 paragraph [0027]); and a connector disposed on the outer surface of the tool body (see figure 2), the connector to couple a removably coupled memory device to the processor (see figure 2); wherein the removably coupled memory device, coupled to the connector, travels with the downhole tool body into and out of the borehole (see figure 1 and page 3 paragraph [0038]), and wherein the processor stores data to the removably coupled memory device while the memory device and downhole tool body are within the borehole (see figure 2 and pages 1-2 paragraph [0013]).

With respect to claim 9, Smits et al. discloses a memory device which comprises at least one of a magnetic storage media, an optical storage media, a random access memory, and a programmable read only memory (see page 3 paragraph [0029], wherein Smits et al. discloses a programmable read only memory).

With respect to claim 10, Smits et al. discloses a receiving device proximate to the downhole tool body (see figure 1); and said receiving device coupled to the processor (see figure 1); wherein the receiving device receives energy whose properties are indicative of at least one of a formation characteristic and a borehole characteristic (see page 2 paragraph [0026]), and wherein the data stored to the memory device by the processor is based on the received energy (see page 2 paragraph [0026]).

With respect to claim 11, Smits et al. discloses a receiving device that receives acoustic energy (see page 2 paragraph [0026]).

With respect to claim 12, Smits et al. discloses a receiving device that receives energy in the form of electromagnetic waves (see page 2 paragraph [0026]).

With respect to claim 13, Smits et al. discloses a receiving device that receives energy in the form of gamma radiation (see page 2 paragraph [0026]).

With respect to claim 14, Smits et al. discloses a connector that is disposed within a recess in the outer surface (see figure 2), and wherein the downhole tool further comprises a cap that seals against an internal surface of the recess (see page 2 paragraph [0027]).

With respect to claim 15, Smits et al. discloses a method comprising: coupling a non-volatile memory device to a logging while drilling (LWD) device through a sidewall of the LWD device (see figure 1 item 19 and figure 2), the coupling while the LWD device is at the surface (see figure 2 and page 2 paragraph [0024] and page 3 paragraphs [0037] and [0038]); lowering the LWD device, along with the non-volatile memory device, into a bore hole (see figure 1 and page 3 paragraph [0038]); operating the LWD device thereby creating data (see figure 1 and page 2 paragraph [0026]); storing the data to the non-volatile memory device (see page 2 paragraphs [0015] and [0026]); raising the LWD device and the non-volatile memory device to the surface (see page 2 paragraph [0024] and page 3 paragraph [0037]); disconnecting the non-volatile memory device from the LWD device (see page 2 paragraph [0024] and page 3 paragraph [0037]); coupling the non-volatile memory device to a surface computer (see

page 2 paragraph [0024]; and reading the data from the non-volatile memory device by the surface computer (see page 2 paragraph [0024]).

With respect to claim 16, Smits et al. discloses coupling the non-volatile memory device to the LWD device which further comprises coupling the non-volatile memory device to a processor of the LWD device (see page 2 paragraph [0026] and figure 2).

With respect to claim 17, Smits et al. further discloses coupling the non-volatile memory device to the processor which further comprises: coupling the non-volatile memory device within a recess in the side-wall (see figures 1 and 2); and placing a cap over the non-volatile memory device and within the recess, and wherein the cap seals against an internal surface of the recess (see page 2 paragraph [0027]).

With respect to claim 19, Smits et al. discloses a downhole tool comprising: a tool body having a box end, the box end couples the tool body within a bottomhole assembly (see figure 1); an electronics insert housing a processor, the electronics insert disposed within the tool body (see figures 1 and 2 and page 2 paragraph [0027]); and a connector accessible through the box end, wherein the connector is external of the electronics insert, and wherein the connector removably couples a memory device to the processor within the electronics insert (see figure 2 and page 2 paragraph [0027]); wherein the memory device, coupled to the connector, travels with the tool body into a borehole, and wherein the processor stores data to the memory device while the memory device and tool body are within the borehole (see figure 1).

With respect to claim 20, Smits et al. discloses a receiving device proximate to the tool body (see figure 2); and said receiving device coupled to the processor; wherein

the receiving device receives energy whose properties are indicative of at least one of a formation characteristic and a borehole characteristic (see figures 1 and 2 and page 2 paragraph [0026]), and wherein the data stored to the memory device by the processor is based on the received energy (see page 2 paragraph [0026]).

With respect to claim 21, Smits et al. discloses a receiving device that receives acoustic energy (see page 2 paragraph [0026]).

With respect to claim 22, Smits et al. discloses a receiving device that receives energy in the form of electromagnetic waves (see page 2 paragraph [0026]).

With respect to claim 23, Smits et al. discloses a receiving device that receives energy in the form of gamma radiation (see page 2 paragraph [0026]).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 8:00-5:30, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nac

William Neuder
Primary Examiner